AMENDMENTS TO THE DRAWINGS

Attached are Replacement Sheets 1 and 2 which include changes to Figures 2, 3, and 4.

REMARKS

I.   Summary

Claims 1-18 are pending in the application. In the non-final Office Action mailed July 15, 2005, claims 1-18 were rejected. Claim 18 has been amended to correct an error in dependency. No new matter has been added. The issues in the Office Action are:

- Claim 18 is objected to.

- The drawings are objected to because the horizontal axis in Figures 2, 3, and 4 in the Replacement Sheet have not been labeled.

- Claims 1, 3-5, 7, and 9-11 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Lehman et al.* (U.S. Patent No. 5,424,537, hereinafter *Lehman*).

- Claims 2, 8, 15, and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lehman* in view of *Bromley* (U.S. Patent Application Publication No. 2001/0030774).

- Claims 6 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lehman* in view of *Brandkamp et al.* (U.S. Patent No. 5,153,745, hereinafter *Brandkamp*).

- Claims 13, 14, 17, and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lehman* in view of *Johnson et al.* (U.S. Patent No. 5,907,742, hereinafter *Johnson*), further in view of *Bromley*.

II.   Objection to the Claims

Claim 18 is objected to. Claim 18, as originally presented, depended erroneously from claim 13. Applicant has amended claim 18 to depend from claim 17. Applicant thanks the Examiner for suggesting the correction. In view of the amendment to claim 18, Applicant respectfully requests that the Examiner withdraw the objection to claim 18.

III.   Objection to the Drawings

The drawings are objected to because the horizontal axis in Figures 2, 3, and 4 in the Replacement Sheet was not labeled. Applicant has labeled the horizontal axis of Figures 2, 3, and 4 as described in the specification on page 6 on the replacement drawing sheets attached hereto. No new matter has been added. In view of the above, Applicant respectfully requests that the Examiner withdraw the objection to the drawings.

IV.   Claim Rejections under 35 U.S.C. § 102(b)

Claims 1, 3-5, 7, and 9-11 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Lehman*. Applicant respectfully traverses the rejection of these claims for the reasons set forth below.

To anticipate a claim under 35 U.S.C. § 102, a reference must teach every element of the claim. *See* M.P.E.P. § 2131.

Claim 1 recites "re-performing the full calibration scan when the difference between the partial calibration scan and the full calibration scan is at least equal to a predetermined amount." *Lehman* teaches a pre-scan calibration which occurs before taking data from a document. *See Lehman* at col. 2, lines 62-68. A second "line" calibration is performed at the beginning of each line scan of the document. *See id. Lehman* teaches changing gain or offset to restore calibration based on the product of the difference between the pre-scan calibration and the line calibration. *See id* at col. 3, lines 10-21. *Lehman* does not teach re-performing a full calibration scan when the difference between the partial calibration scan and the full calibration scan is at least equal to a predetermined amount. Accordingly, *Lehman* does not teach at least the above-recited limitation of claim 1. Thus, *Lehman* does not anticipate claim 1.

Claim 7 recites "adjusting the gains globally for the full calibration scan when the difference between the partial calibration scan and the full calibration scan is less than a predetermined amount." As shown above, *Lehman* teaches a pre-scan calibration which occurs before taking data from a document. *See Lehman* at col. 2, lines 62-68. A second "line" calibration is performed at the beginning of each line scan of the document. *See id. Lehman* teaches adjusting gain and bias converters "at the start of each line scan...and adjusts the gain and bias converters 72, 74 in accordance with the differences." *See id.* at col. 11,

lines 17-25. A calculated correction dG is added to converter 72 to "establish the requisite correction for the data that follows on the scan line." *See id.* at col. 11, lines 32-35. *Lehman* does not teach adjusting the gains globally for the full calibration scan when the difference between the partial calibration scan and the full calibration scan is less than a predetermined amount. Accordingly, *Lehman* does not teach at least the above-recited limitation of claim 7. Thus, *Lehman* does not anticipate claim 7.

Claims 3-5 and 9-11 depend directly or indirectly from claims 1 or 7. As such, they comprise all limitations of the base claim from which they depend. As shown above, *Lehman* fails to teach all limitations of claims 1 and 7. Accordingly, *Lehman* does not teach all limitations of claims 3-5 and 9-11. Thus, *Lehman* does not anticipate claims 3-5 and 9-11. In view of the above, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1, 3-5, 7, and 9-11 under 35 U.S.C. § 102(b) and pass these claims to issue.

V.   Claim Rejections under 35 U.S.C. § 103(a)

Claims 2, 8, 15, and 16

Claims 2, 8, 15, and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lehman* in view of *Bromley* (U.S. Patent Application Publication No. 2001/0030774). Applicant respectfully traverses the rejection of these claims for the reasons provided below.

To establish a prima facie case of obviousness, three basic criteria must be met. *See* M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the first or second criteria, Applicant respectfully asserts that the references do not teach or suggest all the claim limitations.

Claim 15 recites "adjusting the gains globally for the reference scan when the difference between the partial calibration scan and the reference calibration scan is less than a predetermined amount." *Lehman* teaches adjusting gain and bias converters "at the start of each line scan...and adjusts the gain and bias converters 72, 74 in accordance with the differences." *See id.* at col. 11, lines 17-25. A calculated correction dG is added to converter

72 to "establish the requisite correction for the data that follows on the scan line." *See id.* at col. 11, lines 32-35. *Lehman* does not teach or suggest adjusting the gains globally for a reference scan when the difference between a partial calibration scan and a reference calibration scan is less than a predetermined amount. Accordingly, *Lehman* does not teach or suggest at least the above-recited limitation of claim 15. *Bromley* teaches a method for controlling scan conditions for an area to be scanned and determining a minimum scan exposure time based upon comparing the monitored dynamic range of a scan area with a detector dynamic range. *See Bromley* at paragraphs 0012-0016. *Bromley* does not teach or suggest the above-recited limitation of claim 15. Accordingly, *Lehman* in view of *Bromley* does not teach or suggest all limitations of claim 15. Thus, clam 15 is not obvious over the cited references.

Claims 2, 8, and 16 depend directly from claims 1, 7, and 15. As such, each of claims 2, 8, and 16 comprise all limitations of the base claim from which it depends. As shown above, *Lehman* does not teach or suggest all limitations of claims 1, 7, and 15. *Bromley* does not cure the deficiencies of *Lehman* with respect to claims 1, 7, and 15. *Lehman* in view of *Bromley* does not teach or suggest all limitations of claims 1, 7, and 15. Accordingly, *Lehman* in view of *Bromley* does not teach or suggest all limitations of claims 2, 8, and 16. Thus, claims 2, 8, and 16 are not obvious over the cited references. In view of the above, Applicant respectfully requests that the Examiner withdraw the rejection of claims 2, 8, 15, and 16 under 35 U.S.C. § 103(a) and pass these claims to issue.

Claims 6 and 12

Claims 6 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lehman* in view of *Brandkamp*. Applicant respectfully traverses the rejection of these claims for the reasons provided below.

To establish a prima facie case of obviousness, three basic criteria must be met. *See* M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the second criteria, Applicant respectfully asserts that the Examiner has not met the first or third criteria.

Not All Limitations are Taught by the References

Claims 6 and 12 depend directly and indirectly from claims 1 and 7. As such, each of claims 2, 8, and 16 comprise all limitations of the base claim from which it depends. As shown above, *Lehman* does not teach or suggest at least the claim 1 limitation of "re-performing the full calibration scan when the difference between the partial calibration scan and the full calibration scan is at least equal to a predetermined amount." Also as shown above, *Lehman* does not teach or suggest the claim 7 limitation of "adjusting the gains globally for the full calibration scan when the difference between the partial calibration scan and the full calibration scan is less than a predetermined amount." *Brandkamp* does not cure the deficiencies of *Lehman* with respect to the limitations of claims 1 and 7. *Lehman* in view of *Brandkamp* does not teach or suggest all limitations of claims 1 and 7. Accordingly, *Lehman* in view of *Brandkamp* does not teach or suggest all limitations of claims 6 and 12. Thus, claims 6 and 12 are not obvious over the cited references.

Improper Motivation to Combine the References

It is well settled that the fact that a reference can be modified is not sufficient to establish a prima facie case of obviousness. *See* M.P.E.P. § 2143.01. The Examiner has not stated a motivation for modifying the teachings of *Lehman*. The mere fact that a reference can be modified does not render the result obvious unless the prior art also suggests the desirability of the modification. *See* In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. Here, *Lehman* does not teach or suggest the modification proposed by the Examiner. The Examiner states only that one of ordinary skill in the art would have been motivated to modify the teachings of *Brandkamp* "because temperature [sic] of the scanning system is not stable (Brandkamp et al: column 4, lines 36-38) and thus it has to be compensated for." *See* Office Action, page 8. The supplied motivation has no relationship to the combination being proposed. Accordingly, the Examiner has not established the required motivation for modifying the teachings of *Lehman* with the teachings of *Brandkamp*. Thus, the Examiner has not established the first criteria of a *prima facie* obviousness rejection under 35 U.S.C. § 103(a). In view of the above, Applicant respectfully requests that the Examiner withdraw the rejection of claims 6 and 12 under 35 U.S.C. § 103(a) and pass these claims to issue.

Claims 13, 14, 17, and 18

Claims 13, 14, 17, and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lehman* in view of *Johnson,* further in view of *Bromley*. Applicant respectfully traverses the rejection of these claims for the reasons provided below.

To establish a prima facie case of obviousness, three basic criteria must be met. *See* M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the first or second criteria, Applicant respectfully asserts that the references do not teach or suggest all the claim limitations.

Claim 13 recites "performing a PRNU calibration scan and storing the results as a reference scan when the difference between the partial calibration scan and the reference scan is at least equal to a predetermined amount." *Lehman* teaches a pre-scan calibration which occurs before taking data from a document. *See Lehman* at col. 2, lines 62-68. A second "line" calibration is performed at the beginning of each line scan of the document. *See id.* *Lehman* teaches changing gain or offset to restore calibration based on the product of the difference between the pre-scan calibration and the line calibration. *See id* at col. 3, lines 10-21. *Lehman* does not teach performing a PRNU calibration scan and storing the results as a reference scan when the difference between the partial calibration scan and the reference scan is at least equal to a predetermined amount. Accordingly, *Lehman* does not teach or suggest at least the above-recited limitation of claim 13. *Johnson* is not relied upon as teaching those limitations in the Office Action. *Bromley* teaches a method for controlling scan conditions for an area to be scanned and determining a minimum scan exposure time based upon comparing the monitored dynamic range of a scan area with a detector dynamic range. *See Bromley* at paragraphs 0012-0016. *Bromley* does not teach or suggest the above-recited limitation of claim 13. Accordingly, *Lehman* in view of *Johnson,* further in view of *Bromley* does not teach or suggest all limitations of claim 13. Thus, claim 13 is not obvious over the cited references.

Claim 17 recites "re-performing the PRNU calibration scan when the difference between the partial calibration scan and the reference scan is at least equal to a predetermined

amount." *Lehman* teaches a pre-scan calibration which occurs before taking data from a document. *See Lehman* at col. 2, lines 62-68. A second "line" calibration is performed at the beginning of each line scan of the document. *See id.* *Lehman* teaches changing gain or offset to restore calibration based on the product of the difference between the pre-scan calibration and the line calibration. *See id* at col. 3, lines 10-21. *Lehman* does not teach or suggest at least the above-recited limitations of claim 17. *Johnson* is not relied upon as teaching those limitations in the Office Action. *Bromley* teaches a method for controlling scan conditions for an area to be scanned and determining a minimum scan exposure time based upon comparing the monitored dynamic range of a scan area with a detector dynamic range. *See Bromley* at paragraphs 0012-0016. *Bromley* does not teach or suggest the above-recited limitation of claim 17. Accordingly, *Lehman* in view of *Johnson*, further in view of *Bromley* does not teach or suggest all limitations of claim 17.

Claims 14 and 18 depend directly from claim 13 and 17. As such, each of claims 14 and 18 comprise all limitations of base claims 13 and 17, respectively, from which they depend. As shown above, all limitations of claim 13 are not taught or suggested by the cited references. Accordingly, *Lehman* in view of *Johnson*, further in view of *Bromley* does not teach or suggest all limitations of claims 14 and 18. Thus, claims 14 and 18 are not obvious over the cited references. In view of the above, Applicant respectfully requests that the Examiner withdraw the rejection of claims 13, 14, 17, and 18 under 35 U.S.C. § 103(a) and pass these claims to issue.

VI.   Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance.
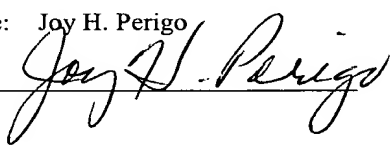
Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10008017-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV482711822US in an envelope addressed to: M/S Amendment, Commissioner for Patents, Alexandria, VA 22313.

Date of Deposit: 08-26-2005

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Attachments: Drawings